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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,359	11/19/2001	Scott D. Slomiany	2100/23	1396
7590	10/31/2005		EXAMINER	
Michael H. Baniak BANIAK PINE & GANNON Suite 1200 150 N. Wacker Drive Chicago, IL 60606			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 10/31/2005				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/993,359

MAILED

Filing Date: November 19, 2001

OCT 31 2005

Appellant(s): SLOMIANY ET AL.

Group 3700

Michael Baniak  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10 August 2005 appealing from the Office action

mailed 24 August 2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief goes beyond that which is actually claimed. Appellant's discussion of the details of the game play is not reflected in the claims.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,263,715	Matsumoto et al.	11-1993
2,125,236	Edgeworth	07-1938

5,647,798                    Falciglia                    07-1997

Bunco Rules <http://www.buncogame.com/brules.shtml>, (20 January 2000)

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

1.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2.     Claims 109-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US Patent Number 5,263,715) in view of Edgeworth (US Patent Number 2,125,236) and Bunco Rules.

**Claim 109:** Matsumoto teaches a gaming machine with a video display device (1) and a CPU (17) having a program operating a dice game. (Abstract). There is a wager input mechanism (6) which registers a wager placed by a player. The program establishes a set of differing game play dice elements (i.e., there are two dice). Matsumoto teaches craps. (Col 2, 61-63) In craps, there is a subset of at least one match point at the start of the game. If a player throws a 7 or 11 (a natural), the player wins. If the player throws a 2, 3, or 12 (a crap), the player loses. If the player throws any other number, the player must continue to throw until the player matches the number originally thrown (the point) or throws a 7. These naturals, craps, and points are all match points. Each match point has a match indicium (i.e., pips on the dice) for potential matching with a subsequent toss

of the dice elements. The program establishes and displays a random toss of a plurality of dice elements at each stage of play, and determines at a stage of play whether the randomly selected indicium matches the match indicium of the match point. There is a payout mechanism providing an award according to a predetermined payable for each match on a toss. (Col 3, 14-18) (Figs 4 & 5)

Matsumoto does not, however, teach Bunco or matching each die element tossed with the indicium on a single die. Edgeworth teaches implementing Bunco on a slot machine. (Col 1, 32-36) In Bunco, each die element tossed is matched with the indicium on a single die. Bunco is an extremely popular game and has been for over a century. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matsumoto in view of Edgeworth (and the rules of Bunco) to have implemented a Bunco game in which each die element tossed is matched with the indicium on a single die in order to take advantage of the popularity of Bunco.

**Claim 110:** The rules of Bunco describe a bonus (i.e., fuzzy dice) for scoring a “Bunco”. A Bunco is when all dice match the match point. Furthermore, progressive jackpots (i.e., those that increase with each round of play until won) are well known to the art. Such bonus awards attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matsumoto in view of Edgeworth and the rules of Bunco to have the payout mechanism include a second payable provided for a bonus award, said second payable increasing in bonus award value with each successive stage of play (a progressive jackpot), and including the step of awarding a bonus award if all dice elements on a toss have the same randomly selected indicium

which also matches a match indicium in order to implement the suggestion of an award for scoring a Bunco and to attract players.

**Claim 111:** Bunco uses three dice (i.e., three dice elements are established and displayed as being tossed at each stage of play.)

**Claim 112:** In Bunco, any match point that is not matched on a toss is eliminated. (If the match point is 2 and the player fails to throw a 2, the "2" round is over and that match point is eliminated.) The rules teach determining whether to continue with a toss on a subsequent stage of play up to a preset maximum number of stages (6) provided that at least one match point remains for each such subsequent stage. If a player tosses a 1 in the 1 round, the 1 round continues until the player tosses a set of dice that does not contain a 1. Then the player tries to match the next match point (2). This continues through six rounds.

**Claim 115:** Edgeworth teaches a game of "twenty six" in which a plurality of match points are established, each of said plurality of match points having a match indicium selected at random (by the player). Some or all of the match indicia of the plurality of match points may thereby be the same. (Col 1, 13-31) (Note that when playing by hand, the player is described as choosing a single match point. But the machine version allows the choosing of multiple match points – "through the intermediation of a token for each point chosen." (Col 1, 26-27))

3. Claims 113 & 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto, Edgeworth and Bunco Rules as applied to claim 109 above, and further in view of Falciglia (US Patent Number 5,647,798).

**Claims 113 & 114:** Matsumoto, Edgeworth and Bunco Rules teach the invention substantially as claimed, but do not teach randomly allocated free advancement features (i.e., “free spins”) or their use to continue the game when it would otherwise terminate. Falciglia teaches “free spins”. Free spins are well known to attract players because they give a player a second chance when the player would otherwise lose. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matsumoto, Edgeworth and Bunco Rules in view of Falciglia to randomly allocate free advancement features (i.e., “free spins”) to be used to continue the game when it would otherwise terminate in order to give a player a second chance when the player would otherwise lose, thus attracting players.

**(10) Response to Argument**

*Examiner’s Summary*

There are at least two ways to look at this case. The first, which Examiner adopted in the rejections above, is that this is a case of adapting current technology (Matsumoto) to play a very popular game (Bunco) as suggested by Edgeworth.

Another way to look at it is that this is a relatively simple case of applying updated technology to old problems. Edgeworth teaches playing a bunco-type game on a slot machine. (Col 1, 32-36) But Edgeworth is old technology. The gaming machine industry has long abandoned the purely mechanical gears and wheels of Edgeworth and adopted the processors and video screens of Matsumoto. Matsumoto is, of course, merely an exemplar of the computerized dice game. Examiner could easily provide a myriad of other examples. Computerized systems are preferable to mechanical systems

for any number of reasons – ease of maintenance, reliability, flexibility, ability to pay automatically, ability to integrate with casino networks, enhanced security, cost – these are just a few of the reasons a person of ordinary skill might wish to adopt computerized technology.

Either way one views the problem, the question become one of how the game would be played. What are the rules? Edgeworth fails to explain these rules – perhaps because Bunco is such a well-known game. Examiner contends that one of ordinary skill in the art would be motivated to look at the rules of the game of bunco when implementing the bunco game. Appellant hotly contests this notion.

Examiner contends that the combination of references teaches Appellant's invention.

### **Response to Appellant's Arguments**

#### **(1) The rejection of claims 109-115**

##### **(a) Appellant's argument with regard to Matsumoto**

Appellant argues that Matsumoto is a machine for throwing dice and nothing more. This is incorrect. Matsumoto is a slot machine that implements dice games. Matsumoto teaches accepting bets and paying winnings. (Fig 4) While it has a user interface that is a little more complex than a slot machine in which the player just pushes a button, the complexity of the user interface does not make it any less of a slot machine.

Appellant further argues that Matsumoto fails to teach matching indicium of each die element with the match indicium of the match point. As pointed out in the rejection above, Matsumoto does teach craps -- a game in which die elements must match indicium

of the match point. But Matsumoto fails to teach matching indicium of each die element with the match indicium of the match point. However, Edgeworth suggests implementing Bunco on a slot machine. As the Bunco rules make plain, in Bunco, each die element must the match indicium of the match point.

Appellant argues that Matsumoto fails to teach a game with successive stages to be played. This is clearly erroneous. As pointed out in the rejection, craps is played in successive stages. The player shoots to determine if he wins (i.e., throws a natural), loses (i.e., craps out) or has a point to match. If he has a point to match he shoots again (in successive stages) until he either matches the point or craps out.

Appellant's statement that Matsumoto determines die speed and rolling angle from a trackball during game play is not germane to the issue of patentability. The fact that Matsumoto has a few extra features not commonly found on a slot machine does not render it any less of a slot machine.

Examiner agrees that Matsumoto does not teach playing Bunco. Yet Matsumoto is clearly adaptable to playing this game. And Edgeworth suggests playing bunco on a slot machine. Examiner contends that the *combination* of Matsumoto and Edgeworth suggests playing Bunco on a slot machine. Appellant does not address the teachings of the combination.

Appellant states, "Matsumoto has nothing to do with the invention claimed herein." This appears to be a mere allegation of patentability and is not an argument. Examiner believes that he has shown that, contrary to Appellant's assertion; Matsumoto

*does* have something to do with Appellant's claimed invention. In fact, Examiner believes that he has shown that the combination of

**(b) Appellant's arguments with regard to Edgeworth**

Appellant states that Edgeworth fails to make up the deficiencies of Matsumoto. Appellant admits that Edgeworth teaches implementing Bunco on a slot machine but insists that their invention is not Bunco, but a Bunco-type dice game. This is a distinction without a difference. Bunco is the very archetype of Bunco-type games.

Appellant argues that Edgeworth fails to teach a wager and a payout on a video display device. Appellant is absolutely correct – Matsumoto teaches a wager and a payout on a video display device. But attacking each reference separately cannot overcome a rejection under 35 USC§103. The question is not what each reference teaches individually, but what the combination of references teaches as a whole. In this case, Matsumoto teaches playing dice games on a slot machine device that accepts wagers and displays the game on a video display. Edgeworth teaches playing the dice game called Bunco on a slot machine. So far, it looks as if the combination is teaching playing Bunco on a slot machine that accepts wagers and displays the game on a video display.

But what does it mean to implement Bunco on a slot machine? What type of game does Edgeworth suggest playing? For that, one of ordinary skill in the art would have looked to the rules of Bunco. We'll discuss more on that topic in subsection (c). But before we look at the applicability of the Bunco rules to the game of Bunco, there are still a few of Appellant's arguments to address.

Appellant argues that Edgeworth teaches away from the claimed invention.

Apparently, Appellant bases this theory on the physical structure of Edgeworth.

Edgeworth, we are reminded, does not have a video display, wager, or payout. Instead, Edgeworth uses gears and fingers to manipulate dice. How this teaches away from implementing Bunco on a slot machine is unclear. After all, Appellant admits that Edgeworth contains such a teaching. It seems that to Appellant, anything that does not anticipate the claimed invention, teaches away from it. This is not what is meant by “teaching away”.

**(c) The applicability of Bunco rules**

Appellant starts with a synopsis of the history of the game of Bunco and admits the popularity of the game. Appellant then describes the game of Bunco – the number of players, team play, the shouts of Bunco, matching the points, etc. The Appellant then states that the claimed invention is based on an individual player’s turn during a round of Bunco. Appellant then describes differences between Bunco and the Appellant’s invention. Appellant’s invention has two differences: (1) Any number that has been rolled on every stage of the game is a match point. (2) The match point may be randomly selected instead of increasing in each round.

The problem with these arguments is that they are not commensurate with the scope of the claims. While they may be disclosed in Appellant’s specification, they are not contained in Appellant’s claims. Differences between the disclosed game and Bunco cannot distinguish over the prior art unless they are actually claimed. As discussed in the rejection, the rules to Bunco read on the invention that is actually claimed.

Before proceeding with the discussion of Appellant's arguments, Examiner wishes to point out what the combination of references teaches. Appellant admits that Bunco is very popular. The popularity of the game suggests that it should be implemented in a computerized version. Matsumoto teaches a gaming machine (with wagering, payouts, paytables, etc.) for playing a dice game with match points and a number of successive stages (i.e., craps). As in the traditional game of Bunco, a number of people can sit around a table and play. But while Matsumoto is well adapted to playing the game, Matsumoto does not teach Bunco. Edgeworth teaches implementing a Bunco-type game for one person (i.e., an individual player's turn during a round of Bunco) on a slot machine with wagering. Edgeworth fails to teach the details of the Bunco game it suggests. Examiner contends that one of ordinary skill in the art would be motivated to look to the rules of the game if he were going to implement it. It turns out that these rules to Bunco read on the *claimed* invention. Taken together as a whole, these three references teach Appellant's claimed invention.

**(d) Hindsight**

Appellant argues that by choosing references that taken together teach Appellant's game, Examiner has engaged in improper hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, it is admitted that Bunco is a tremendously popular game. One of ordinary skill in the art would have been motivated to implement this game on a slot machine in order to attract players who enjoy Bunco. The slot machine industry has a voracious appetite for new games. The average slot machine remains popular for about six months. So practitioners of the art are always looking for new games. And, of course, the art is replete with games that have been implemented on slot machines. There are slot machine versions, of poker, blackjack, craps, MONOPOLY, BATTLESHIP, OTHELLO, and dominoes – to name just a few. The need for new games is the driving force behind innovations in the slot machine art and provides a powerful motivation to its practitioners.

Matsumoto is a modern slot machine that is used in playing a dice game. It explicitly discloses craps, but it is clearly adapted to playing virtually any dice game. As noted several times above, craps has many elements of Bunco. Furthermore, one of ordinary skill in the art would have known that Bunco could be implemented on a slot machine – Edgeworth teaches that. Once a decision is made to implement Bunco, it is natural to look to the rules of the game for guidance.

There is not a single element that is gleaned only from Appellant's specification. Every part of the reasoning behind the combination of references – including the motivation behind combining the references -- was available to one of ordinary skill in

the art without considering Appellant's specification at all. Therefore, there was no improper hindsight.

Appellant's other arguments under this heading are a rehash of those discussed in detail above – except for an argument that no one else has adapted Bunco to a video game format. While this may be true, it does not change the teachings of the prior art. These teachings render the claimed invention obvious.

**(e) Structures allegedly not found in the prior art**

In this section, Appellant appears to be attempting to argue each claim separately – in spite of his clear statement that the claims stand and fall together. If Appellant intends to argue the claims separately, Appellant is required to explain why each claim is separately patentable. Appellant has failed to make such an argument – merely pointing out additional limitations to the claims is not an acceptable argument.

In the interest of brevity, Examiner will not address each claim individually – referring back to the rejections above. Examiner will merely point out that the arguments with respect to claim 109 are not commensurate with the scope of the claims.

**(2) Rejection of Claims 113 & 114**

Appellant merely states that these claims depend from claim 109 and should be allowed for the same reasons. Appellant presents no further argument except to say that the claims contain a further limitation. For the reasons discussed at length above, the Examiner contends that the claims do not distinguish over the prior art.

**(3) Conclusion**

As noted above, Appellant's invention is taught by the prior art. Whether the popularity of the Bunco game would have led one of ordinary skill to implement Bunco on Matsumoto's gaming machine following Edgeworth's suggestion and using Bunco's rules for guidance or the march of technological progress would have led one of ordinary skill to have updated Edgeworth's notion of implementing Bunco on a slot machine using Matsumoto's modern equipment (and Bunco's rules for guidance), only one conclusion is possible. The art clearly teaches Appellant's *claimed* invention.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

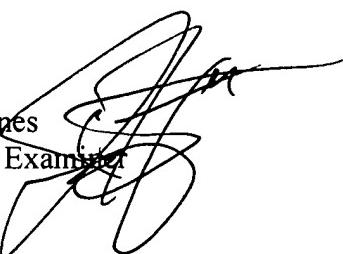
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Corbett B. Coburn III  
Patent Examiner

Conferees:



Scott Jones  
Primary Examiner



John Hotaling  
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